IFW

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37 CFR 1.7(c) FILING RECEIPT AND TRANSMITTAL LETTER WITH AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT

Neifeld Docket No.:CAT/29US-SCROCO

US/PCT Application/Patent No.:09/401,939

Priority Data:

Inventor:Scroggie

Client Ref::

US/PCT File/Issue Date:

USPTO Confirmation No.: 5333

Title:System and Method for Providing Shopping Aids and Incentives to Customers Through a Computer Network

THE FOLLOWING HAS BEEN RECEIVED IN THE U.S. PATENT OFFICE ON THE DATE STAMPED HEREON:

37 CFR 1.7(c) Filing Receipt and Transmittal Letter with Authorization to Charge Deposit Account (in duplicate)
Response to Notice of non-Responsive Communication
Copy of Complete Filing from September 16, 2005, Which Contains:
   Date-Stamped Filing Receipt Indicating Receipt by the USPTO on Spetember 16, 2005
   Check for $260.00
   Transmittal Letter and Authorization to Charge Deposit Account (in duplicate)
   37 CFR 1.111 Reply by Applicant to a non-Final Office Action
   37 CFR 1.321 Terminal Disclaimer Over a Patent by Attorney
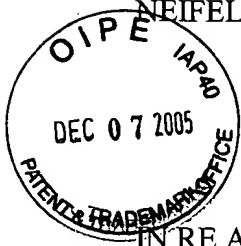   37 CFR 1.321 Terminal Disclaimer Over an Application by Attorney

The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 50-2106 . A duplicate copy of this sheet is enclosed.

Respectfully Submitted,

17/7/65

DATE

Richard A. Neifeld
Registration No.35,299
Attorney of Record

	PcLaw Matter	Lawyer	Amount	Explanation		Date Entered	Initials
Fees:							
Fees:							
Disbursements:	PcLaw Matter	G/L Account 5010	Amount	Explanation		Date Entered	Initials

NEIFELD DOCKET NO: CAT/29US-SCROCO

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF: SCROGGIE

USPTO CONFIRMATION CODE: 5333

SERIAL NO.: 09/401,939

FILED: September 23, 1999

EXAMINER: JEAN D JANVIER

GROUP ART UNIT: 3622

FOR: System and Method for Providing Shopping Aids and Incentives to Customers Through a
Computer Network

ASSISTANT COMMISSIONER FOR PATENTS

ALEXANDRIA, VA 22313

RESPONSE TO NOTICE OF NON-RESPONSIVE COMMUNICATION

Sir:

In response to the office communication mailed November 25, 2005, the applicant
responds as follows:

1

1.   **Non-Responsive Communication**

The examiner received only one of two required terminal disclaimers that was filed by the applicant on September 16, 2005. In the office communication mailed November 25, 2005 page 2 lines 4-10, the examiner stated that:
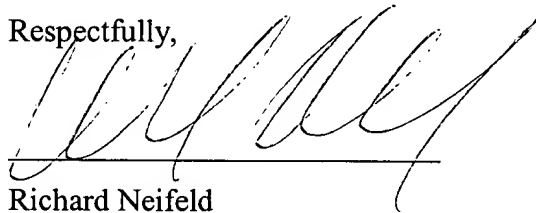
> Although the Applicant has indicated, in his response filed on 09/16/2005, that two Terminal Disclaimers were submitted in response to the Obviousness Double Patenting Rejection over US Application No. 09/478,351 and USP 6,185,541, however, our record has shown that only one Terminal Disclaimer related to the Application was received and recorded by the Office. No Terminal Disclaimer with respect to USP 6,185,541 was submitted or received by the Office. Hence, the response, filed under 37 CFR 1.111, is said to be incomplete or not fully responsive.

In response, the applicant submits herewith a copy of the complete filing from September 16, 2005 containing both a 37 CFR 1.321 terminal disclaimer over a patent by attorney with respect to USP 6,185,541 and a 37 CFR 1.321 terminal disclaimer over an application by attorney with respect to U.S. Application No. 09/478,351. The applicant points out that no fee is currently due because the September 16, 2005 filing included a check for $260 to pay the fees for filing two terminal disclaimers.

Respectfully,

12/6/05
Date

Richard Neifeld
Attorney of Record
Reg. No. 35,299

Printed: December 6, 2005 (10:22am)
Y:\Clients\Catalina\CAT-29US-SCRO\CAT29US-SCROCO\Draft\ResponseTD_051130.wpd

NEIFELD IP LAW, P.C.
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37 CFR 1.7(c) FILING RECEIPT

Neifeld Docket No.: CAT/29US-SCROCO

Client Ref:

US/PCT Application No.: 09/401,939

US/PCT Application Filing Date: September 23, 1999

Priority Data:

USPTO Confirmation No.: 5333

Inventor: SCROGGIE

Title: System and Method for Providing Shopping Aids and Incentives to Customers Through a Computer Network

THE FOLLOWING HAS BEEN RECEIVED IN THE U.S. PATENT OFFICE ON THE DATE STAMPED HEREON:

Check for $260.00
Transmittal Letter and Authorization to Charge Deposit Account (in duplicate)
37 CFR 1.111 Reply by Applicant to a non-Final Office Action
37 CFR 1.321 Terminal Disclaimer Over a Patent by Attorney
37 CFR 1.321 Terminal Disclaimer Over an Application by Attorney

	PcLaw Matter	Lawyer	Amount	Explanation	Date Entered	Initials
Fees:	CAT29USSCRO	BTM	300	CAT/29US-SCROCO firm charge for paying a government fee for two terminal disclaimers.	9/16/2005	BTM
Fees:						

Disbursements:	PcLaw Matter	G/L Account	Amount	Explanation	Date Entered	Initials
	CAT29USSCRO	5010	260	CAT/29US-SCROCO gov. fees for paying a government fee for two terminal disclaimers.	9/16/2005	BTM

Printed: April 21, 2005 (5:19pm)
Y:\Info\FirmForms\Forms_Patent\US\Templates-DoNotUse\FR-US.wpd

Reply_TermDis_CAT-29US-SCROCO_050919.pdf

NEIFELD IP LAW, PC   003880

DATE   : Sep 16/2005
CHE # : 03880
AMOUNT: $260.00
ACCOUNT: GENERAL - 1
PAID TO: Commisioner of Patents
         Commissioner for Patents
         PO. Box 1450
         Alexandria
         VA
         22313-1451

CLIENT: CATA - Catalina Marketing Corporation
MATTER: CAT29USSCRO

NEIFELD IP LAW, PC   CHECK NO.   003880
4813-B EISENHOWER AVE.   68-106/560
ALEXANDRIA, VA 22304   **BURKE & HERBERT BANK & TRUST CO.**
                                   Alexandria, VA

Two Hundred Sixty ***00/100

                                                 DATE   AMOUNT
PAY TO THE ORDER OF   Sep 16/2005 $260.00

    Commisioner of Patents
    Commissioner for Patents
    PO Box 1450
    Alexandria, VA 22313-1451

CAT/29US-SCROCO gov fees for 2 terminal disclaimers   *Bruce Margulis*   MP

          ⑈003880⑈ ⑈056001066⑈ ⑈07710349⑈2⑈

NEIFELD IP LAW, PC   003880

DATE   : Sep 16/2005   ** GENERAL BALANCES **
CHE # : 03880   UNBILLED DISBS: 0.00
AMOUNT: $260.00   A/R BALANCE   :   211.50
ACCOUNT: GENERAL - 1
PAID TO: Commisioner of Patents

CLIENT: CATA - Catalina Marketing Corporation
MATTER: CAT29USSCRO   ** TRUST BALANCES **
LAWYER: Richard A. Neifeld
200 Carillon Parkway

St. Petersburg
FL
33716   TRUST BALANCE :   0.00
Attention: Justin Summer, Esq.☐☐CC to: Carol Chapman☐☐Catalina Ref: CAT/29U

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TRANSMITTAL LETTER AND
AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT

ASSISTANT COMMISSIONER FOR PATENTS
ALEXANDRIA, VA 22313

> RE: Attorney Docket No.: CAT/29US-SCROCO
>   Application No.:09/401,939
>   Filed: September 23, 1999
>   Inventor: SCROGGIE
>   Group Art Unit:3622
>   Examiner:JANVIER
>   Title: System and Method for Providing Shopping Aids and Incentives to Customers
>   Through a Computer Network

SIR:

       Attached hereto for filing are the following papers:

37 CFR 1.111 Reply by Applicant to a non-Final Office Action
37 CFR 1.321 Terminal Disclaimer Over a Patent by Attorney
37 CFR 1.321 Terminal Disclaimer Over an Application by Attorney

       Our check in the amount of 260.00   is attached covering the required fees.

       The Commissioner is hereby authorized to charge any fees which may be required, or
credit any overpayment, to Deposit Account Number 50-2106   . A duplicate copy of this sheet
is enclosed.

                                      Respectfully Submitted,

9/16/05
_____   _____
DATE   Richard A. Neifeld, Ph.D.
                                      Registration No. 35,299
                                      Attorney of Record

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF: SCROGGIE

USPTO CONFIRMATION CODE: 5333

SERIAL NO.: 09/401,939

FILED: September 23, 1999

EXAMINER: JEAN D JANVIER

GROUP ART UNIT: 3622

FOR: System and Method for Providing Shopping Aids and Incentives to Customers Through a Computer Network

ASSISTANT COMMISSIONER FOR PATENTS

ALEXANDRIA, VA 22313

37 CFR 1.111 REPLY BY APPLICANT TO A NON-FINAL OFFICE ACTION

Sir:

In response to the non-final office action mailed June 29, 2005, the applicant responds as follows:

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1. **The Objections to Claims 32, 45, and 58**

The examiner objects to claims 32, 45, and 58, stating that:

Concerning claims 32, 45 and 58, in the limitations "generating token data depending on said selection data", the term "token" defines coupon offers preferably in coded form, such as bar codes, but the token is not immediately recognized as a coupon per se (although it has coupon data encoded thereon). Subsequently, the token is transmitted to the user or user's computer and the user takes the token to his selected store, encoded on the token, and receives, upon purchasing the required item as encoded on the token, the appropriate purchase incentive or discount or promotion automatically or a voucher, redeemable on a future purchase, may be provided to the user instead and in accordance with the purchase incentive or promotion received from the central computer database and stored in the local store server database (See embodiments of figs. 13 and 18 of the specification). In other words, the token, which can very well be a piece of paper, has data similar to coupon data encoded thereon except for the discount value or the purchase incentive itself that is stored locally at the redemption site or on a remote central repository accessible by the redemption site system. In any event, whether a token or a coupon (e-coupon) is being presented for use, the redemption is virtually or substantially performed the same way, especially if the coupon distribution and redemption are conducted electronically.

Finally, "generating a purchase incentive based. . . " is interpreted as --retrieving the purchase incentive from the local store server in response to the token bearer's or identified user's purchase of the required item as read from the token--. Here, the "purchase incentive" was earlier transmitted from the main computer central repository to the selected local store server database in response to the user's selection.

Appropriate correction is required. [Office action mailed June 29, 2005 page 3 lines 3-23.]

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In response, the applicant traverses the requirement because it is indefinite. The examiner provides what appears to be a claim construction, not identification of an error. Therefore, the applicant respectfully requests that the examiner either (1) specify the error and requirement or (2) remove the requirement.

2. **Double Patenting Rejection of Claims 32, 45, and 58**

The examiner has issued two double patenting rejections of claims 32, 45, and 58, stating that:

Claims 32, 45 and 58 (i.e. 32-70) of the Instant Application are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over at least claims 65 and 67 of co-pending Application Serial No. 09/478,351. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

Claim 32 of the Application substantially recites the limitations of claim 65 of Application Serial No. 09/478, 351, as shown.

32. (Once Amended) A computer implemented method for distributing purchasing incentives to consumers, comprising:

transmitting promotion data identifying a plurality of product discounts from a main computer to a personal computer over a computer network;

displaying said plurality of product discounts at said personal computer based on said promotion data;

transmitting selection data designating at least one product discount selected from said plurality of product discounts from said personal computer to said main computer over said computer network;

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generating token data depending on said selection data;

transmitting said token data from said main computer to said personal computer over said computer network;

identifying said token data in a retail store in association with items being purchased at said retail store;

determining discount items being purchased corresponding to said at least one product discount from said identified token data; and

generating a purchase incentive based on said discount items.

65. (Twice Amended) A method for distributing purchasing incentives to customers, said method comprising [the steps of]:

transmitting a prompt for an electronic [mailing] mail address of a customer from a central computer over a computer network to a personal computer;

in response to said prompt, transmitting said electronic [mailing] mail address over said computer network to said central computer;

associating at [the] said central computer the electronic [mailing] mail address with a unique customer identification;

transmitting an incentive offer over said computer network to said personal computer based on data stored at the central computer and associated with the unique customer identification;

transmitting incentive offer selection data over said computer network to said central computer; and

in response to said selection data, transmitting data defining an incentive token over said computer network to said personal computer, wherein said incentive token is exercisable for said

incentive at a store designated by said incentive offer.

As shown above, claim 32 omits the underlined portions of claim 65. However, one skilled in the art would have understood that these underlined portions or limitations are implicitly recited in claim 32. Further, this mailing address (including zip code) is part of the demographic data originally collected from the user during the initial encounter (user's first contact with the system) to decide, for example, whether or not the user lives in a qualified zip code, i.e. a zip code associated with a participating local store, before the user is allowed to receive and select product offers therefrom. In other words, before the user is allowed to select products from the system, as recited in claim 32, he must first provide his mailing address (at least his zip code) and this mailing address can be used at least to transmit the generated token, samples or marketing literature, to the user.

Additionally, it is common practice to collect demographic information including mailing address from a user and use the collected information to send, via the Post Office, promotional information, such as coupons, to the user.

Therefore, an ordinary skilled artisan would have been motivated at the time of the invention to collect demographic information, including mailing address having a defined zip code, from the user during a registration process and use the collected data to decide whether the user lives in a qualified zip code and to mail, subsequent to this determination, a product coupon or a generated token having encoded thereon the user's product offer selections.

This is a provisional obviousness-type double patenting rejection since the conflicting claims have not in fact been patented.

Claims 32, 45 and 58 (i.e. 32-70) of the Instant Application are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7 and 8 of U.S. Patent No. 6,185,541. Although the conflicting claims are not identical, they are not patentably distinct from each

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other.

For example, claim 32 of the Instant Application substantially recites the limitations of claim 8 of the Patent, as shown below.

32. (Once Amended) A computer implemented method for distributing purchasing incentives to consumers, comprising:

transmitting promotion data identifying a plurality of product discounts from a main computer to a personal computer over a computer network;

displaying said plurality of product discounts at said personal computer based on said promotion data;

transmitting selection data designating at least one product discount selected from said plurality of product discounts from said personal computer to said main computer over said computer network;

generating token data depending on said selection data;

transmitting said token data from said main computer to said personal computer over said computer network;

identifying said token data in a retail store in association with items being purchased at said retail store;

determining discount items being purchased corresponding to said at least one product discount from said identified token data; and

generating a purchase incentive based on said discount items.

8. A method for distributing purchasing incentives to customers, said method comprising the steps of:

<u>transmitting a prompt for identity data from a central</u>

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<u>computer over a computer network to a personal computer;</u>

    <u>in response to said prompt, transmitting said identity data</u>
<u>over said computer network to said central computer;</u>

    transmitting an incentive offer over said computer network
to said personal computer;

    transmitting incentive offer selection data over said
computer network to said central computer; and

    in response to said selection data, transmitting data defining
an incentive token over said computer network to said personal
computer, wherein said incentive token is exercisable for said
incentive at a store designated by said incentive offer, **further
comprising transmitting terms of said purchasing incentive to
an in-store server computer.**

As shown above, claim 32 omits the underlined portions of claim 8.
However, one skilled in the art would have understood that these underlined
portions or limitations are implicitly recited in claim 32. Further, this mailing
address or identity data (including zip code) is part of the demographic data
originally collected from the user during the initial encounter (user's first contact
with the system) to decide, for example, whether or not the user lives in a
qualified zip code, i.e. a zip code associated with a participating local store, before
the user is allowed to receive and select product offers therefrom. In other words,
before the user is allowed to select products from the system, as recited in claim
32, he must first provide his mailing address (at least his zip code) and this
mailing address can be used at least to transmit the generated token, samples or
marketing literature, to the user. It is further recognized, broadly interpreted, that
the user's registration data are used, among other things, to create an ID or code or
Password or identity data for the user and the user uses this cod [sic] (identity
data) to log into the system and select coupon or product or incentive offers

therefrom.

Additionally, it is common practice to collect demographic information including mailing address from a user and use the collected information to send, via the Post Office, promotional information, such as coupons, to the user. Finally, using a password or identity data to log into a remote server or central computer is well documented in the art.

Therefore, an ordinary skilled artisan would have been motivated at the time of the invention to collect demographic information, including mailing address having a defined zip code, from the user during a registration process and use the collected data to decide whether the user lives in a qualified zip code, to generate a code (identity data) or password for the user and to mail, subsequent to this determination, a product coupon or a generated token having encoded thereon the user's product offer selections made online at the main computer using his generated password or code or identity data to log into the main computer.
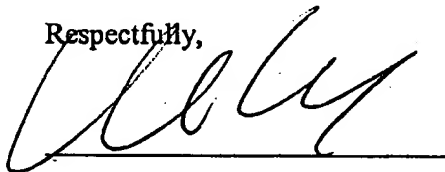
Here, Applicant can amend the conflicting claims of the Instant Application or file a Terminal Disclaimer to overcome the Obviousness Double Patenting Rejection. [Office action mailed June 29, 2005 page 4 line 19 through page 10 line 11.]

In response, the applicant submits herewith two terminal disclaimers to overcome the two obviousness-type double patenting rejections over claims in application 09/478, 351 and patent 6,185, 541, respectively.

9/16/05

Date

Respectfully,

Richard Neifeld
Attorney of Record
Reg. No. 35,299

8

BTM

Printed: September 16, 2005 (2:46pm)

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NEIFELD DOCKET NO: CAT/29US-SCROCO

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF: Scroggie et al.

USPTO CONFIRMATION CODE: 5333

SERIAL NO: 09/401,939

FILED: 9/23/1999

EXAMINER: Janvier

GROUP ART UNIT: 3622

FOR: System and Method for Providing Shopping Aids and Incentives to Customers Through a Computer Network

37 CFR 1.321 TERMINAL DISCLAIMER OVER A PATENT BY ATTORNEY

ASSISTANT COMMISSIONER FOR PATENTS

ALEXANDRIA, VA 22313

Sir:

Now comes the undersigned, Attorney of Record in the present application, who avers as follows:

Catalina Marketing International, Inc. is the owner of the entire right, title and interest in and to the invention claimed and disclosed in the above-captioned patent application by virtue of assignment, said Assignment having been recorded in the U.S. Patent and Trademark Office at reel no. 013159, frame(s) 0638.

Catalina Marketing International, Inc. hereby disclaims the terminal part of any patent granted on the above-captioned application, which would extend beyond the expiration date of the full statutory term as presently shortened by any terminal disclaimer of U.S. Patent No. 6,185,541, and hereby agrees that any patent so granted on said above captioned application shall be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to U.S. patent 6,185,541, this agreement to run with any patent granted on the above-captioned application and to be binding upon the grantee, its successors or assigns.

Catalina Marketing International, Inc. does not disclaim any terminal part of any patent

granted on the above-captioned application that would extend to the full statutory term as presently shortened by any terminal disclaimer of U.S. patent 6,185,541 in the event that it later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. 1.321(a), has all claims canceled by a reexamination certificate, or is otherwise terminated prior to the expiration of its statutory term as presently shortened by any terminal disclaimer, except for the separation of legal title stated above.

Respectfully Submitted,

9/16/2005
DATE

Richard A. Neifeld, Ph.D.
Registration No. 35,299
Attorney of Record

BTM

Y:\Clients\Catalina\CAT-29US-SCRO\CAT29US-SCROCO\Draft\TD_Patent_050916.wpd
Printed: September 16, 2005 (2:40pm)

NEIFELD DOCKET NO: CAT/29US-SCROCO

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF: Scroggie et al.

USPTO CONFIRMATION CODE: 5333

SERIAL NO: 09/401,939

FILED: 9/23/1999

EXAMINER: Stephen Gravini

GROUP ART UNIT: 3622

FOR: System and Method for Providing Shopping Aids and Incentives to Customers Through a Computer Network

37 CFR 1.321 TERMINAL DISCLAIMER OVER AN APPLICATION BY ATTORNEY

ASSISTANT COMMISSIONER FOR PATENTS

ALEXANDRIA, VA 22313

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Now comes the undersigned, Attorney of Record in the present application, who avers as follows:

Catalina Marketing International, Inc. is the owner of the entire right, title and interest in and to the invention claimed and disclosed in the above-captioned patent application by virtue of assignment, said Assignment having been recorded in the U.S. Patent and Trademark Office at reel no. 013159, frame(s) 0638.

Catalina Marketing International, Inc. hereby disclaims the terminal part of any patent granted on the above-captioned application, which would extend beyond the expiration date of the full statutory term as presently shortened by any terminal disclaimer of any patent that issues for pending U.S. Patent Application No. 09/478,351, and hereby agrees that any patent so granted on said above captioned application shall be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to any patent that issues for pending U.S. Application No. 09/478,351 this agreement to run with any patent granted on the above-captioned application and to be binding upon the grantee, its successors or assigns.

Catalina Marketing International, Inc. does not disclaim any terminal part of any patent granted on the above-captioned application that would extend to the full statutory term as presently shortened by any terminal disclaimer of any patent that issues to pending U.S. Application No. 09/478,351 in the event that it later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. 1.321(a), has all claims canceled by a reexamination certificate, or is otherwise terminated prior to the expiration of its statutory term as presently shortened by any terminal disclaimer, except for the separation of legal title stated above.

Respectfully Submitted,

DATE

Richard A. Neifeld, Ph.D.
Registration No. 35,299
Attorney of Record

BTM

Y:\Clients\Catalina\CAT-29US-SCRO\CAT29US-SCROCO\Draft\TD_Application_050916.wpd

Printed: September 16, 2005 (2:39pm)